

REMARKS

In the Office Action,¹ the Examiner took the following actions:

- 1) objected to the specification for minor informalities;
- 2) rejected claims 1-14 and 18-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- 3) rejected claims 1, 2, and 4-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication 2004/0064731 to Nguyen et al. ("*Nguyen*"); and
- 4) rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of U.S. Application Publication 2003/0005111 to Allan ("*Allan*");

Applicants respectfully traverse all the objection and rejections listed above.

Objection to the Specification

The Examiner objected to the specification for use of trademarks Java and Java Script. In response, Applicants have amended the specification to expressly label Java and Java Script as trademarks. Applicants therefore request the Examiner to withdraw the objection to the specification.

Rejection of Claims 1-14 and 18-20 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-14 and 18-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. However, to advance prosecution, Applicants have amended independent claims 1 and 18. Accordingly,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1-14 and 18-20 under 35 U.S.C. § 101.

Rejection of Claims 1, 2, and 4-20 under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1, 2, and 4-20 under 35 U.S.C. § 102(e) as being anticipated by *Nguyen*. In order to properly establish that *Nguyen* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that *Nguyen* fails to teach or suggest each and every element of Applicants' claimed invention.

Independent claim 1 calls for a combination including, for example, "generat[ing] a first trace output." *Nguyen* fails to teach or suggest at least this element of claim 1.

The technique of tracing is well known to software developers and to one of ordinary skill in the art of computer science. For example, "In software engineering, tracing is a specialized use of logging to record information about a program's execution. This information is typically used by programmers for debugging purposes, and additionally, depending on the type and detail of information contained in a trace log, by experienced system administrators or technical support personnel to diagnose common problems with software." Wikipedia,

[http://en.wikipedia.org/wiki/Tracing_\(software\)](http://en.wikipedia.org/wiki/Tracing_(software)), as of June 4, 2007. The present

application uses this specialized meaning of the term “trace.” See, e.g., p. 4, lines 21-23 (“To aid the application developer in the debugging process, a trace program executed by a client agent and a server agent can be used to generate trace outputs”).

The Examiner cites paragraph 0039 of *Nguyen* as a teaching of the above-quoted element of claim 1. Office Action, p. 4. However, this portion and other portions of *Nguyen* merely disclose monitoring systems and applications in order to gather events and then report those events. In *Nguyen*, “[e]xamples of monitored application (102) include Enterprise Resource Planning (ERP) software, databases, patch management software, enterprise asset management software, virus detection software, etc.” *Nguyen*, [0026]. However, *Nguyen* does not teach or suggest tracing these applications for debugging purposes and producing a trace output. Indeed, *Nguyen* is completely silent as to any sort of tracing. Instead, *Nguyen* teaches gathering events from event “log files, SNMP traps, packet sniffers, a smart card reader, etc.” *Nguyen*, [0053]. A person of ordinary skill in the art knows that monitoring based on event logs, SNMP traps, packet sniffing, and smart card readers, as taught by *Nguyen*, does not constitute “generat[ing] a first trace output,” as recited in claim 1.

Furthermore, claim 1 calls for the combination including, for example, “generat[ing] the integrated trace output file.” *Nguyen* fails to teach or suggest at least this element of claim 1.

The Examiner argues that the correlation and aggregation component of *Nguyen* constitutes the above-quoted element of claim 1. Office Action. p. 4. However, the correlation and aggregation component of *Nguyen* does not “generate [a] . . . file,” as

recited in claim 1. Although *Nguyen* teaches producing a report of the events, mere production of a report does not teach generating a file. Indeed, *Nguyen* mentions files only as sources of events, not as an output of events. For example, a “server agent may monitor . . . file . . . changes made to the web server” (*Nguyen*, [0053]) and “data may be collected from system log-files” (*Nguyen*, [0009]). Therefore, *Nguyen* fails to teach or suggest “generat[ing] the integrated trace output file,” as recited in claim 1.

For at least the reasons given above, *Nguyen* fails to anticipate independent claim 1. Furthermore, independent claims 15 and 18 are also distinguishable over *Nguyen* for reason similar to those given above with respect to claim 1. In addition, dependent claims 2, 4-14, 16, 17, 19 and 20 are also allowable over *Nguyen* at least by virtue of their dependence from their respective independent claims 1, 15, and 18. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 2, and 4-20 under 35 U.S.C. § 102(e) as being anticipated by *Nguyen*.

Rejection of Claim 3 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of *Allan* because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art (taken separately or in combination) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to

identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

The Examiner argues that *Allan* discloses the element of claim 3, which depends from claim 1 though intervening claim 2, and thus requires all the elements of claim 1. Even assuming that the Examiner’s characterization of *Allan* is correct, which Applicants do not concede, *Allan* fails to cure the above-noted deficiencies of *Nguyen*. That is, *Allan* also fails to teach or suggest “generat[ing] a first trace output” and “generat[ing] the integrated trace output file,” as recited in claim 1, and required by claim 3.

Therefore, *Nguyen* and *Allan*, taken alone or in any reasonable combination, fail to teach or suggest all the elements of claim 3. For at least this reason, the cited references fail to support a *prima facie* case of obviousness. The rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* and *Allan* is thus improper and should be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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